

**REMARKS**

**Status of the Claims**

Claims 1-15 and 17-18 are pending in this application. No claims have been canceled. Claims 19 and 20 have been added. Support for claim 19 is discussed below. Support for claim 20 is found in the specification at page 47, lines 1-5. Claim 1 has been amended to recite ". . . photosensitive silver halide in an amount that is 10 wt. % or less of a coated amount of photosensitive silver halide in a separate photosensitive layer". Claim 1 has also been amended to recite that the separate photosensitive layer contains a photosensitive silver halide and substantially no organic silver salt. Support is found in the specification at page 4, lines 11-16, which states that the organic silver salt and silver halide grains may be in separate layers, which indicates that the photosensitive layer may have no or substantially no organic silver salt. In addition, see in the examples the preparation and coating of photosensitive layer coating liquid on page 83, where the photosensitive layer does not contain the organic acid silver salt dispersion. As such, Applicants submit no new matter has been added by the above claim amendments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 1-11 as indefinite for the phrase "in an amount that is 10 wt. % or less of the coated amount of photosensitive silver halide in the photosensitive layer." Applicants amend claim 1 to recite "in an amount that is 10 wt. % or less of a coated amount of photosensitive silver halide in a separate photosensitive layer". As such, Applicants submit that claim 1 particularly and distinctly recites the subject matter of the claimed invention. Thus, the rejection has been overcome and should be withdrawn.

Rejection Under 35 U.S.C. § 102(b) or in the Alternative § 103(a)

The Examiner rejects claims 1-3, 12, 13, 15, 17 and 18 as anticipated by or obvious over EP 0803764 (EP '764). Applicants traverse the rejection and respectfully request the withdrawal thereof.

The present invention is directed to a heat developable image recording material that comprises two separate layers: (1) a silver supplying layer that has 10 wt. % or less of the coated amount of the photosensitive silver halide in a separate photosensitive layer; and (2) a photosensitive layer containing photosensitive silver halide and no or substantially no organic silver salt.

EP '764 discloses a photosensitive layer that contains a photosensitive silver salt and an organic silver salt. The

photographic material of EP '764 also contains a nonphotosensitive layer and a back layer. The nonphotosensitive layer contains an organic silver salt, a reducing agent and a binder.

EP '764 fails to disclose a photosensitive layer that contains no or substantially no organic acid silver salt. EP '764 also fails to disclose the specifically claimed amount of photosensitive silver halide.

As such, Applicants submit that the present invention is distinguished from EP '764 on the basis that the present invention has no or substantially no organic acid silver salt in the photosensitive layer, whereas the photographic material of EP '764 always has organic acid silver salt in the photosensitive layer. Thus, Applicants respectfully request that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejects claims 4-11 and 14 as obvious over EP '764 in view of Murray '324, Murray '515 and Toya '419. Applicants traverse the rejection and respectfully request the withdrawal thereof.

Applicants rely on the arguments stated above regarding the insufficiencies in EP '764 in traversing this rejection. EP '764 fails to disclose or suggest a photosensitive layer having no or substantially no organic silver salt. The secondary references,

Murray '324, Murray '515 and Toya '419 fail to disclose or suggest removing the organic silver salt from the photosensitive layer. As such, Applicants submit that the combination of references fails to disclose or suggest each and every claim limitation of the present invention.

Moreover, Applicants submit that one of ordinary skill in the art would not be motivated to combine the secondary references with EP '764 to arrive at the present invention.

Toya '419 discloses a heat developable photographic material that has a light sensitive layer comprising light sensitive silver halide, organic silver salt and a reducing agent. All of these components are in one layer of the material as opposed to the present invention where there are two separate layers, the silver supplying layer and the photosensitive layer. Also, EP '764 discloses a multi-layer photographic material. In view of these inconsistent teachings, one of ordinary skill in the art would not combine the teachings in Toya '419 with the teachings in EP '764 to arrive at the present invention.

Murray '324 discloses a photothermographic element, which uses a photosensitive silver halide in catalytic proximity to an organic silver salt. As stated above, the present invention is directed to the photosensitive layer having no or substantially no organic silver salt. As Murray '324 and EP '764 fail to disclose all the limitations of the present invention, one of ordinary skill in the

art would not be motivated to combine the references to arrive at the present invention.

Murray '515 discloses a photothermographic material that has a photosensitive layer that comprises a reducible silver source. However, the present invention is directed to the photosensitive layer having no or substantially no organic silver salt. As Murray '515 and EP '764 fail to disclose all the limitations of the present invention, one of ordinary skill in the art would not be motivated to combine the references to arrive at the present invention.

As such, Applicants submit that the rejection should be withdrawn as the Examiner has failed to make a *prima facie* case of obviousness.

Conclusion

As Applicants have addressed and overcome all rejections in the Office Action, Applicants respectfully request that the rejections be withdrawn and the claims allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)



VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend the claims as follows:

1. (Twice amended) A heat-developable image-recording material comprising on a support:

a silver-supplying layer [containing] comprising an organic silver salt, a reducing agent, an organic binder and photosensitive silver halide in an amount that is 10 wt% or less of a coated amount of photosensitive silver halide in a separate [the] photosensitive layer; and

a separate photosensitive layer [containing] comprising a photosensitive silver halide and substantially no organic silver salt;

the heat-developable image-recording material further containing an electron-transfer agent.

Claims 19 and 20 have been added.

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